

**IN THE U.S. DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

APPLE INC.,

Plaintiff,

v.

MASIMO CORPORATION and
SOUND UNITED, LLC,

Defendants.

MASIMO CORPORATION and
CERCACOR LABORATORIES, INC.,

Counter-Claimants,

v.

APPLE INC.

Counter-Defendant.

C.A. No. 22-1378-MN-JLH

JURY TRIAL DEMANDED

**DECLARATION OF EDWARD M. CANNON IN SUPPORT OF
DEFENDANTS MASIMO CORPORATION AND SOUND UNITED, LLC'S
MOTION FOR STAY PENDING *INTER PARTES* REVIEW**

I, Edward M. Cannon, declare as follows:

1. I am a partner with the law firm of Knobbe, Martens, Olson & Bear, LLP, counsel of record for Defendants Masimo Corporation and Sound United, LLC in the above-captioned matter. I have personal knowledge of the matters set forth herein and if I am called upon to testify, I could and would testify competently thereto.

2. I submit this Declaration in support of Defendants' Motion for Stay pending IPR.

3. Masimo filed petitions for IPR challenging the patentability of each of Apple's asserted utility patents. I am counsel of record for Masimo in each of these petitions.

4. On February 27, 2023, Masimo filed petition IPR2023-00634 challenging all claims 1-20 of the '783 patent. On September 25, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 1** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00634.

5. On February 27, 2023, Masimo filed petition IPR2023-00635 challenging all claims 1-20 of the '054 patent. On September 18, 2023, the USPTO denied institution of IPR. Attached hereto as **Exhibit 2** is a true and correct copy of the USPTO's decision denying institution of IPR2023-00635. On October 18, 2023, Masimo filed a request for rehearing of the Board's decision denying institution.

6. On March 6, 2023, Masimo filed petition IPR2023-00664 challenging all claims 1-24 of the '352 patent. On September 20, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 3** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00664. On December 13, 2023, Apple moved to conditionally amend challenged claims 3-5, 7, 8, 11-13, 15, 16, 19-21, 23, and 24 of the '352 patent. Attached

hereto as **Exhibit 4** is a true and correct copy of Patent Owner's Contingent Motion to Amend in IPR2023-00664.

7. On March 20, 2023, Masimo filed petition IPR2023-00734 challenging all claims 1-19 of the '491 patent. On October 5, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 5** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00734.

8. On March 22, 2023, Masimo filed petition IPR2023-00745 challenging claims 1-4 and 8-22 of the '257 patent. On October 16, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 6** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00745. Attached hereto as **Exhibit 7** is a true and correct copy of an email that Grace Kim, counsel of record for Apple in IPR2023-00745, sent to the trials@uspto.gov on December 14, 2023. As shown therein, Ms. Kim states: "Patent Owner, Apple Inc., intends to file a motion to amend in the IPR2023-00745 proceeding."

9. On April 4, 2023, Masimo filed petition IPR2023-00807 challenging all claims 1-20 of the '483 patent. On November 21, 2023, the USPTO denied institution of IPR. Attached hereto as **Exhibit 8** is a true and correct copy of the USPTO's decision denying institution of IPR2023-00807.

10. Attached hereto as **Exhibit 9** is a true and correct copy of Defendant Apple Inc.'s Memorandum of Points and Authorities in Support of Its Motion to Stay the Patent Infringement

Case Pending *Inter Partes* Review Proceedings in *Masimo Corp. et al. v. Apple Inc.*, Case No. 8:20-cv-00048-JVS-JDE (C.D. Cal.).

11. Attached hereto as **Exhibit 10** is a true and correct copy of the redacted Order Regarding Motion for Stay by Judge James V. Selna in *Masimo Corp. et al. v. Apple Inc.*, Case No. 8:20-cv-00048-JVS-JDE (C.D. Cal.).

12. Attached hereto as **Exhibit 11** is a true and correct copy of Apple's Opposition to AliveCor's Motion to Stay Pending *Inter Partes* Review in *Apple Inc. v. AliveCor, Inc.*, Case No. 4:22-cv-07608-HSG (N.D. Cal.).

13. Attached hereto as **Exhibit 12** is a true and correct copy of a printout of a December 19, 2023 Docket Navigator documents search using search parameters "Types of Document: Motion to Stay Pending Inter Partes Review" and "Defendants: Apple Inc.".

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on December 20, 2023, in Irvine, California.

/s/ Edward M. Cannon
Edward M. Cannon

CERTIFICATE OF SERVICE

I hereby certify that on December 20, 2023, I electronically filed the foregoing with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

I further certify that I caused to be served copies of the foregoing document on December 20, 2023, upon the following in the manner indicated:

VIA ELECTRONIC MAIL:

David E. Moore Bindu A. Palapura Andrew L. Brown Hercules Plaza, 6th Floor 1313 N. Market Street Wilmington, DE 19801 dmoore@potteranderson.com bpalapura@potteranderson.com abrown@potteranderson.com	John M. Desmarais Kerri-Ann Limbeek Cosmin Maier Jordan N. Malz Benjamin N. Luehrs Joze Welsh Jamie L. Kringstein Jennifer M. Przybylski Carson Olsheski Jeffrey Scott Seddon, II Amy I. Wann Raymond N. Habbaz Lee Matalon Taeg Sang Cho Eli Balsam Patrick Reilly Marie Weisfeiler Ryan G. Thorne Paul A. Bondor Desmarais LLP 230 Park Avenue, 26th Floor New York, NY 10169 jdesmarais@desmaraisllp.com klimbeek@desmaraisllp.com cmaier@desmaraisllp.com jmalz@desmaraisllp.com bluehrs@desmaraisllp.com jwelsh@desmaraisllp.com jkringstein@desmaraisllp.com jprzybylski@desmaraisllp.com colsheski@desmaraisllp.com jseddon@desmaraisllp.com
--	--

	awann@desmaraisllp.com rhabbaz@desmaraisllp.com lmatalon@desmaraisllp.com tcho@desmaraisllp.com ebalsam@desmaraisllp.com preilly@desmaraisllp.com mweisfeiler@desmaraisllp.com rthorne@desmaraisllp.com pbondor@desmaraisllp.com
Peter C. Magic Kyle Curry Maria Tartakovsky DESMARAIS LLP 101 California Street San Francisco, CA 94111 pmagic@desmaraisllp.com kcurry@desmaraisllp.com mtartakovsky@desmaraisllp.com	Jennifer Milici Dominic Vote Leon B. Greenfield Heath Brooks John O'Toole Wilmer Cutler Pickering Hale and Dorr LLP 2100 Pennsylvania Avenue NW Washington, DC 20037 jennifer.milici@wilmerhale.com dominic.vote@wilmerhale.com leon.greenfield@wilmerhale.com heath.brooks@wilmerhale.com john.otoole@wilmerhale.com
Mark A. Ford Vinita Ferrera Wilmer Cutler Pickering Hale and Dorr LLP 60 State Street Boston, MA 02109 mark.ford@wilmerhale.com vinita.ferrera@wilmerhale.com	David J. Cho David J. Shaw Desmarais LLP 1899 Pennsylvania Avenue NW, Suite 400 Washington, DC 20006 dcho@desmaraisllp.com dshaw@desmaraisllp.com
Lydia Turnage Wilmer Cutler Pickering Hale and Dorr LLP 7 World Trade Center 250 Greenwich Street New York, NY 10007 lydia.turnage@wilmerhale.com	Bethany Stevens Hannah Cannom Walker Stevens Cannom LLP 500 Molino Street, Suite 118 Los Angeles, CA 90013 bstevens@wscllp.com hcannom@wscllp.com
Lauren Ige Cristina Salcedo Wilmer Cutler Pickering Hale and Dorr LLP 250 South Grand Avenue, Suite 2400 Los Angeles, CA 90071 lauren.ige@wilmerhale.com cristina.salcedo@wilmerhale.com	IPservice@potteranderson.com
AppleMasimoService@desmaraisllp.com	whmasimoantitrustservice@wilmerhale.com

Dated: December 20, 2023

/s/ Megan C. Haney

Megan C. Haney (#5016)